UNITED S[redacted]S DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/125,888	08/27/98	PETTERSSON A	1103326-0519

007470
WHITE & CASE LLP
PATENT DEPARTMENT
1155 AVENUE OF THE AMERICAS
NEW YORK NY 10036

QM12/0301

EXAMINER	
ARNOLD III,T	
ART UNIT	**PAPER NUMBER**
3728	3

DATE MAILED: 03/01/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/125,888	Pettersson et al
Examiner	**Group Art Unit**
Troy Arnold	3728

☒ Responsive to communication(s) filed on *Jan 21, 2001*

☒ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire _____ month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) *1-11 and 27-36* is/are pending in the applicat

Of the above, claim(s) *1-10 and 27-36* is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *11* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Election/Restriction

Amended claims 1-10 and newly submitted claims 27-36 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: these claims are now directed to a method of using a laminate, and a method of using a container, both of which constitute a sixth distinct invention, different from the other five inventions delineated in paper No. 3, in which a restriction was required. In that paper, groups I-IV were characterized as described by structure claims, and the fifth group as a process of forming a package. In paper No 4, **the applicant did not argue with this characterization of these claims**, therefore the amending of these claims as method claims constitutes an impermissible shift. Clearly, claim 11, the structure claim, does not require the "exposing the laminate to ethylene oxide gas" step of claim 1 and therefore the container can be used in a different process.

Since applicant has received an action on the merits for the originally presented invention in claims 1-11, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 1-10 and 27-36 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 11 is rejected under 35 U.S.C. 102(b) as being anticipated by Jones. Jones teaches a laminate having 1) an inner layer comprising a polyolefin, 2) an outer layer comprising a polyester, polyolefin or polyamide, and 3) an intermediate layer comprising silicon oxide. See Fig 1 and column 4, lines 19-33 where Jones describes an inner layer comprising polyethylene, a polyolefin. (Polyethylene is a polyolefin, as defined in Webster's Collegiate Dictionary, 10th edition.) See column 5, lines 29-33 for a description of an outer layer comprising a polyamide. See column 4, lines 34-59 for a description of an intermediate layer comprising silicon oxide. Regarding the underscored amendment in the last two lines of claim 11, claims to a process involving or purported capabilities of a structure are given no patentable weight. This phrase is deemed to constitute no more than a mere statement of intended use, providing no distinction whatsoever over the claimed laminate. Should the laminate of Jones be so exposed, it would inherently have such a property.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jones in view of Toyo Boseki KK, European Patent No 0550039 A2 and Oike Ind Co, Japanese Patent No. 5084276. It is clear from the disclosure of Jones that there are many different layering possibilities or permutations for a laminate structure, and it is also clear that there are many different "genus," "species," or sub "sub-species" of materials, generically referred to as plastics, which could be employed as the layering materials for a laminate. All of the materials specifically claimed in the instant application are taught in at least one of the three prior art references above, and they all discuss many alternative material and layering arrangements. It would have been obvious in view of the references to one of ordinary skill in that art at the time the invention was made to modify the laminate of Jones, for the purpose of suiting a given condition, or mechanical or chemical expedient.

Response to Arguments

Applicant's arguments filed have been fully considered but they are not persuasive. Regarding claim 11 as amended, it is submitted that no structure is claimed by "[exposing a

laminate] to ethylene oxide gas wherein the laminate acts as a barrier material to the ethylene oxide gas." Also, it is reiterated that patents are not granted for newly discovered capabilities that a previously patented invention inherently possessed, or for newly discovered manners of use for which it was suited but not known to be used.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Troy Arnold whose telephone number is (703)305-0621. The Examiner can

normally be reached Monday through Friday from 9:00 am until 5:00 pm EST. Any questions of a general nature pertaining to the application can be directed to the group receptionist whose number is (703) 308-1148.

TGA

February 28, 2001

Supervisory Patent Examiner
Group 3700